

Docket No.: 57042-069



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Donald L. SCHILLING

Serial No.: 09/732,185

Filed: December 08, 2000

For: PACKET SPREAD-SPECTRUM TRANSMITTER

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Group Art Unit: 2665

Examiner: S. Nguyen

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PETITION FOR NEW OFFICE ACTION AND
TO RESET THE PERIOD FOR REPLY
UNDER MPEP § 710.06

Commissioner for Patents
Washington, DC 20231

Sir:

Upon review of the Office Action dated May 22, 2002, a number of formal defects were noted.

By this petition, filed within the first month of the period for response set in the May 22, 2002 Action (June 22, 2002 having fallen on a Saturday), Applicant asks that the Office correct the defects the Action, re-mail the corrected Action, and reset the period for response, to allow Applicant a meaningful opportunity to respond to the issues actually being raised by the Examiner. Attention is directed to MPEP section 710.06.

The Defects:

1. Omission - The space at the top of the Office Action Summary form PTO-326) for the shortened period for response is blank.

2. Improper Finality - The Office Action introduces a new ground of rejection with respect to claims 17-19, 23, 24, 28-30, 34, 35, 39-41, 44 and 45 over newly cited U.S. Patent No. 5,260,967 to Schilling (hereinafter the '967 Patent) and U.S. Patent No. 5,619,526 to Kim. The Examiner gave no explanation as to any grounds for making this Action final. None of these claims was amended in the response to the earlier Action.

It is noted that Kim was cited in the latest Information Disclosure Statement (IDS). A Reissue (35,402) corresponding to the '967 Patent was also cited in that IDS. However, since the Examiner gave no reason for making the Action final, on the record, the Examiner has not relied on the IDS as a basis for the late citation of the Schilling '967 Patent and Kim. To the contrary, on page 5, the Examiner explains that the citation of the Schilling '967 Patent and Kim was to address Applicant's assertion that an earlier taking of official notice was improper without the citation of supporting references. Since the reason for application of the new references was the improper use of official notice in the first Action, it is submitted that the May 22, 2002 second Action should not have been made final.

3. Inconsistency in Application of References - The rejection of Claims 17-19, 23, 24, 28-30, 34, 35, 39-41, 44 and 45 applies the Schilling '951 in view of the '967 Patent and Kim. Although the initial statement of the rejection does not mention the '486 Patent to Koyanagi, the claims treated in the new rejection all depend from claims rejected over the '951 Patent in combination with the '486 Patent to Koyanagi, and the explanation of the rejection of claims 23 et seq. relies on the '486 Patent to Koyanagi (see first four lines on page 4 of the Action).

The inclusion of claims 23, 24, 34, 35, 44 and 45 in the rejection based in part on the '967 Patent and the Kim Patent also is inconsistent. The explanation of this rejection applies the '967 Patent for a teaching of encryption and applies Kim for a teaching of scrambling. Claims 23, 24,

34, 35, 44 and 45 do not require encryption or scrambling, and the specific discussion of these claims refers only to the base reference ('951 Patent) and the '486 Patent to Koyanagi that was omitted from the initial statement of this rejection.

On these facts it is unclear what prior patents the Examiner is applying to the different claims included in the second art rejection (section # 3 of the Action). Accurate citations are necessary in the rejections to enable full consideration of the documents applied and the proposed combinations thereof, and thus, a complete and appropriate response to the merits of the Examiner's art rejections.

Relief Sought:

1. Applicant requests a re-mailing of the second Office Action.
2. Applicant requests that the newly mailed second Office Action **not** be made final, to allow Applicant an opportunity to respond to the new issues raised by the art rejection(s) based in part on the '967 Patent and Kim.
3. Applicant further requests that the new second Office Action properly and consistently identify the claims rejected and the prior patents included in each proposed combination.
4. Applicant requests a reset of the period for response, to run a full three months from the new mailing date of the re-mailed/revised second Office Action.

Fee:

It is believed that a fee in support of this petition is unnecessary, since the reasons for this petition arose as a result of errors at the U.S. Patent and Trademark Office. However, in the event that a fee is necessary, Please charge the petition fee or any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account

500417 and please credit any excess fees to such deposit account. Applicant intends to provide a timely response fully addressing all issues raised by the Examiner, preferably when fully understood from the new Office Action.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read "Keith E. George". The signature is fluid and cursive, with the first name "Keith" being more prominent.

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